

OA Item #1: Rejection of claims 36-41 under 35 USC § 251 – Diligence in Filing:

The examiner has rejected claims 36-41 as “being broadened in a reissue application filed outside the two year statutory period”. Applicant does not dispute the assertion by the examiner that the submitted claims are broaden claims. However, Applicant asserts that Applicant filed Applicant’s application within the two year statutory period. Applicant notes that 35 USC § 251 fourth paragraph reads as follows:

“No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.”.

Therefore, in order to satisfy 35 USC § 251 fourth paragraph, an applicant must file his application within two years of the issue date of the “original” patent. Applicant respectfully points out that Applicant’s current application is a reissue application of US patent 5,908,057 which issued on June 1, 1999. Applicant’s reissue application was filed on May 29, 2001. Inasmuch as May 29, 2001 is less than two years after June 1, 1999, Applicant respectfully asserts that Applicant’s reissue application complies with the requirements of 35 USC § 251 for a broadening reissue application.

In his “Response to Arguments”, the examiner states his disagreement with Applicant’s proposed definition of “original” which Applicant bases on the cited case of *United States Filter Corporation et al. v. Ionics*. The examiner argues that because the citation is directed to the doctrine of recapture and not necessarily to the defining of the word “original”, the examiner finds the citation as “non-analogous” and thus unconvincing. Applicant respectfully disagrees with this finding. Applicant proposes that even though that case was written to address an issue of recapture, such intent of the case does not invalidate the definition by the case of the word “original” nor does it un-teach the meaning of the word. Furthermore, if one can only rely on a case as teaching the definition of a word when the case is seen as analogous to the point of law in question, then the definition of words are subject to the shifting topics of law. Applicant respectfully suggests that such is not the case.

Applicant further notes that Applicant has cited numerous cases where broadening reissue applications have been allowed when such reissue applications have been filed within two years of the issue date of the “original” patent that is seeking to be reissued but beyond two years from the issue date of an earlier patent in the application’s genealogy. Applicant notes that at least one of the cases was appealed to the board of patent appeals and interferences and allowed by the same. Applicant notes that the examiner did not address such numerous cited cases.

Conclusion:

Applicant respectfully submits that because the present reissue application was properly filed on US 5,908,057 within the permissible two-year statutory window, that the present rejection be withdrawn. Applicant submits that the arguments presented herein have placed the claims in condition for allowance. Action in accordance therewith is earnestly solicited.

If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: November 12, 2004

Respectfully submitted,



Michael R. Schramm